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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/014,687	12/11/2001	Anthony Earle	81444F-P	3189

7590

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EXAMINER

NICOLAS, FREDERICK C

ART UNIT

PAPER NUMBER

3754

DATE MAILED: 04/02/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/014,687

Applicant(s)

EARLE ET AL. 

Examiner

Frederick C. Nicolas

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 11 December 2001.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) 1-9, 12, 15, 17 and 18 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 10, 11, 13, 14, 16 and 19-21 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 11 December 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2&3.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

**DETAILED ACTION**

***Election/Restrictions***

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1-9, drawn to a method of delivering processing solution to a processing apparatus, classified in class 222, subclass 1.
  - II. Claims 10-21, drawn to a delivery unit for supplying low viscosity processing solution to a processing apparatus, classified in class 222, subclass 86.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions I and II are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)). In this case the method as claimed can be practiced by another materially different apparatus, since it does not require a storage container having a nozzle, as required by invention II.

3. Because these inventions are distinct for the reasons given above and the search required for Group I is not required for Group II, restriction for examination purposes as indicated is proper.

4. This application contains claims directed to the following patentably distinct species of the claimed invention:

Species A: Figure 1.

Species B: Figure 2.

Species C: Figure 3.

Species D: Figures 8A-8D.

Species E: Figure 9.

Species F: Figure 10.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claims 1 and 10 are generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over

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the prior art, the evidence or admission may be used in a rejection under 35

U.S.C. 103(a) of the other invention.

5. During a telephone conversation with the applicant's attorney Frank Pincelli on 3/25/2003 a provisional election was made without traverse to prosecute the invention of group II, claims 10-21, and Species A: Figure 1, claims 10-11,13-14,16 and 19-21. Affirmation of this election must be made by applicant in replying to this Office action. Claims 1-9,12,15 and 17-18 withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

6. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

### ***Drawings***

7. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the claimed subject matter in claim 10, line 2, "a processing apparatus", the claimed subject matter in claim 19, line 2, "identification means" and as well as the claimed subject matter in claim 21, lines 1-2, "a processing apparatus" must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

***Claim Objections***

8. Claim 21 is objected to because the claimed limitation "a processing apparatus" as recited in line 2, and "a processing apparatus" as recited in claim 10, line 2, are vague because it is not clear if the claimed limitation in claim 21, line 2, "a processing apparatus" is the same as the claimed limitation noted in claim 10 above. Applicant should restructure the claimed language to prevent double inclusion throughout the claims.

***Claim Rejections - 35 USC § 102***

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

10. Claims 10,13 and 20-21 are rejected under 35 U.S.C. 102(b) as being anticipated by Taylor et al. 0354663 A2.

Taylor et al. discloses a delivery unit for supplying low viscosity processing solution to a processing apparatus as seen in Figure 1, which comprises a storage container 1 having a nozzle 5, a piston 4, and means for activating the piston such that a fixed amount of solution is delivered out of the container via the nozzle each time the piston is activated (col. 6, ll. 49-56).

***Claim Rejections - 35 USC § 103***

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Taylor et al. 0354663 A2 in view of Hoffmann et al. 4,522,316.

Taylor et al. has all the features of the claimed invention except that a plastic seal is provided behind the piston portion. Hoffmann et al. teaches the use of a plastic seal 6 behind a piston 2 of a storage container 1.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the plastic seal of Hoffmann et al. onto the invention of Taylor et al. as such, in order to prevent dirt from entering behind the piston, as taught by Hoffmann et al. (col. 4, ll. 40-42).

13. Claims 14 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Taylor et al. 0354663 A2 in view of Peng 5,615,807.

Taylor et al. has all the features of the claimed invention except that the activation means comprises a rod for pushing the piston. Peng teaches the use an activation means for a storage container 14 (col. 4, ll. 28-57), where the activation means comprises a rod 16 for pushing a piston, the rod being in connection with a clutch plate 26 activated by a cam 36.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to substitute the means for activating the piston of Taylor et al. with Peng's means for activating the piston as such, in order to provide a smooth continuous feeding during long runs while permitting the feeding to be cleanly and precisely terminated without spurious feeding, as taught by Peng (col. 4, ll. 28-31).

14. Claim 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over Taylor et al. 0354663 A2 in view of Koehler et al. 5,538,161.

Taylor et al. has all the features of the claimed invention except that the unit is provided with identification means. Koehler et al. teaches a delivery unit 300 having a container 314, where the delivery unit is provided with identification means 390 to identify product within the container (col. 5, ll. 1-3).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to utilize the teaching of Koehler et al. onto the invention of Taylor et al. as such, in order to identify the product of the container, as taught by Koehler et al. (col. 5, ll. 1-2).

### ***Conclusion***

15. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Dentler et al. 5,595,327, Kayser 4,356,938, Etter 2,754,033, Bratton 3,774,809, Trumbull 3,188,057, Dang et al. 5,680,967, Green 4,648,532, Sartain 4,323,176, Sherbondy 2,831,615, Massey 4,213,546, Barry 2,587,683 and Krahe et al. 3,140,078 disclose other types of delivery unit.



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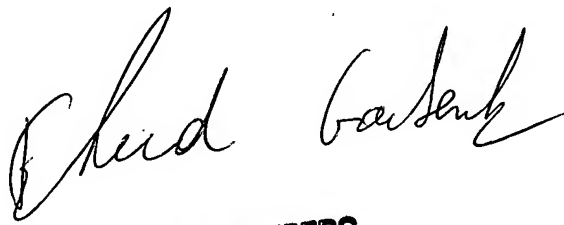
16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Frederick C. Nicolas whose telephone number is (703)-305-6385. The examiner can normally be reached on Monday - Friday from 9:00 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mancene L. Gene or acting supervisor Ehud Gartenberg can be reached on (703)-308-2696. The fax phone numbers for the organization where this application or proceeding is assigned are (703)-872-9302 for regular communications and (703)-872-9303 for After Final communication.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)-308-0861.

FN  
March 28, 2003

(F.N.) 3/28/03



**EHUD GARTENBERG**  
**PRIMARY EXAMINER**